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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

LIM, KRISNA

ART UNIT PAPER NUMBER

2153

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/654,330

Applicant(s)

HERROD ET AL.

Examiner

Krisna Lim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 55-82 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 55-82 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

1. Claims 55-82 are presented for examination, and claims 1-54 were canceled.
2. On page 1, 13 and other, the cited application should be updated with the current status such as the U.S. Patent No., the issue date, etc. Also, applicants are attempting to incorporate subject matter by reference to the U.S. Application No. 08/691,263. Applicants are reminded to review the conditions for incorporation by reference of "essential" and "no-essential" material (M.P.E.P. § 608.01(p)). Moreover, it is unclear what application is related to this application. For example, the background of the invention, applicants mentioned that this application is related to the US Application Serial No. 08/691,263 while in the declaration applicants referred to 08/827,263 instead.
3. It is requested that a future correspondence from applicants have line numbering for the recitation of claims, if possible, as this will aid in the future correspondence from the examiner.
4. Claim 55 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 55, line 3, "the terminal" lacks clear antecedent basis. It is unclear how can a server is in the terminal. What's kind of the terminal is it?
5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

7. Claims 55, 67 and 77 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Dahm et al. [U.S. Patent No. 6,466,783].

8. Dahm et al. disclosed (e.g., see Figs. 1-6B) the invention substantially as claimed. Taking claims 55, 67 and 77 as exemplary claims, the reference disclosed a wireless data communication system (e.g., see Fig. 1), comprising:

a) a computer network having a plurality of access points (HTTP Interface 202, UDP Interface 206) for users to access the network;

b) a mobile, hand-held terminal (portable device, mobile device 250 of Fig. 2B, 106 of Fig. 1, cols. 3-4) for wireless connection to a computer network having access points (Figs. 1, 2A and 2B), including:

i) a server in the terminal (264) for establishing a user-accessible site having a network address for the terminal;

ii) a memory in the terminal (258 of Fig. 2B) for storing data in a file at the site;

iii) a wireless communication in the terminal (252 of Fig. 2B); and

c) a locator in the network (Fig. 2A) for receiving an access request to the site via one of the access points (HTTP Interface 202, UDP Interface 206) and for transmitting the data in the file to one access point in wireless communication with the communicator in the terminal (e.g., col. 2, lines 1-32, col. 3, line 59, to col. 4, line 48).

9. Claims 56-65, 68-76 and 78-82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dahm et al. as applied to claims 55, 67 and 77 above, and further in view of Official Notice and Russell et al. [U.S. Patent No. 5,905,248].

10. As to claims 56-60, 68-71 and 78-80, while Dahm et al. disclosed a plurality of two-way wireless interactive communication devices (e.g., see col. 3, line 59, to col. 4, line 23), Dahm et al. did not explicitly detail a well known device, for example, a transducer for converting input signal, input video signal, input audio signal into electrical signal representing data (e.g., an image file, a sound file, a hazard file, a symbol file, or whatever file) stored in the file. Examiner takes the official notice that a transducer is a well known device for converting sound, temperature, pressure, light or other signal to or from an electrical signal (e.g., see any electronic or computer

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dictionary). Thus, it would have been obvious to one of ordinary skilled in the art at the time the invention was made to incorporate the well-known device into Dahm's interactive communication device in order to facilitate the communication between pluralities of different devices.

11. As to claim 72 and 81, Dahm et al. did not explicitly detail the use of bar code, bar code label, bar code reader or scanner. Such features are clearly taught by Russell et al. (e.g., see an abstract, Figs. 1-7, col. 1 (line 61) to col. 9 (line 67). Saving and benefits associated with the Internet-based transactions that could be automatically launched and executed in response to reading of the bar code would have been a desirable feature in the art as suggested by Russell et al. (e.g., see col. 1, line 61, to col. 3, line 32). Thus, it would have been obvious to one of ordinary skilled in the art at the time the invention was made to combine the teaching of these two references in order to achieve such desirable feature. Moreover, they are directed to a wireless user-held network terminal

12. As to claim, 61, the feature of the terminal has a printer driver for printing a hard copy of the data. Such feature

13. As to claims 62 and 74, Dahm et al. disclosed the terminal has a display for displaying the data (116 of Fig. 1, 260 of Fig. 2B, col. 2, line 10).

14. As to claims 63, Dahm et al. disclosed the server creates a network page (obviously displayed by the browser 264) for displaying the data, and wherein the terminal has a display (260 of Fig. 2B) for displaying the network page.

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15. As to claims 64 and 76, Dahm et al. disclosed the terminal has a manually operated control (e.g., Keyboard 262 of Fig. 2B, 118 of Fig. 1, col. 2, line 10) for changing how the data is displayed.

16. As to claims 65-66 and 75, Dahm et al. disclosed the display is displayed in an area and a tool for selecting a zone on the display for storage in the file (426 of Fig. 4, 614 of Fig. 6B).

17. As to claims 73 and 82, while Dahm et al. disclosed a system for providing visual interfaces to mobile subscriber account services including a plurality of two-way wireless interactive communication devices (e.g., see col. 3, line 59, to col. 4, line 23) that allowed the mobile device 250 having a browser and UDP Interface for accessing the Internet wirelessly via wireless network 208 and a proxy server 200, Dahm et al. did not explicitly detail or mention that the mobile subscribers were being billed for download the data in the file. It would have been obvious to one of ordinary skill in the art at the time the invention was made to recognize that the mobile subscriber must be billed for whatever services that they are subscribed because the mobile device must subscribe and pay the bill in order to receive the services.

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The references are cited in the Form PTO-892 for the applicant's review.

A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) days from the mail date of this letter. Failure to respond within the period for response will result in **ABANDONMENT** of the application (see 35 U.S.C 133, M.P.E.P 710.02, 710.02(b)).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krisna Lim whose telephone number is 571-272-3956

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The examiner can normally be reached on Monday to Wednesday and Friday from 7:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess, can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KI

December 11, 2004



KRISNA LIM
PRIMARY EXAMINER